

Remarks

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 1-5, 8-11, 13, 16-19, 22-24, 26, and 29-48 are pending in the application, with claims 1, 16, 29, and 39 being the independent claims. Claims 6-7, 12, 14-15, 20-21, 25, and 27-28 were previously, No claims are sought to be amended. No new claims are sought to be added.

Based on the above amendment and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

Claim Objections

Claim 39 has been objected because of an alleged informality. The Examiner contends that the statement that "a method as in claim 1" should be replaced by the phrase "a program storage device as in claim 16." Applicants respectfully traverse.

Applicants respectfully disagree with the Examiner. The element is properly recited as " identify those topics associated with the stored data items identified in the result set, wherein said topics are identified by a method as in claim 1." The intent is to use the method defined by claim 1 to identify a topic, which does not infer or require a separate program storage device. In fact, the topics could be generated by a separate program storage device or the same program storage device used to perform the other elements of claim 39, thus the proposed correction by the Examiner would add an

unnecessary limitation to the claim. Reconsideration and withdrawal of this objection is respectfully requested.

Rejections under 35 U.S.C. § 101

The Examiner has rejected Claims 1-5, 8-11, 13, 16-19, 22-24, 26 and 29-48 under 35 U.S.C. § 101, alleging that the bodies of the independent claims 1 and 16 in view of MPEP 2106 (IV)(C)(2)((2)) are non statutory because they are mere abstract ideas and are lacking of **real world useful results**. Applicants respectfully traverse.

Courts have repeatedly found practical applications of abstract ideas (e.g., a mathematical algorithm, formula, or calculation) to constitute patentable subject matter because they produce "a useful, concrete and tangible result". For example, in *In re Alappat*, the Federal Circuit held that data transformed by a machine using mathematical calculations to provide a smooth waveform display constituted patentable subject matter because the smooth waveform is a useful, concrete and tangible result. *See, In re Alappat*, 31 U.S.P.Q.2d 1545 (Fed. Cir. 1994). The Federal Circuit held that process and machine claims for the transformation of electrocardiograph signals from a patient's heartbeat using mathematical calculations are statutory. *See, Arrhythmia Research Technology Inc. v. Corazonix Corp.*, 22 U.S.P.Q.2d 1033 (Fed. Cir. 1992). Finally, in *State Street*, the Federal Circuit held that the transformation of data representing discrete dollar amounts by a machine using mathematical calculations into a final share price constitutes patentable subject matter because the final share price is a useful, concrete

and tangible result. *See, State Street Bank & Trust v. Signature Financial Group*, 47 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1998).

Applicants submit that the method of identifying topics, as recited in independent claims 1 and 16, is clearly statutory subject matter having a useful, concrete and tangible result. Such a useful, concrete and tangible result is explicitly recited in claims 1 and 16. For instance, both claims specifically recite that the method is for generating topics. The method is further made tangible in claim 1 as is described by generating a topic and storing a topic within the claim elements. Claim 16 is made tangible by including the element of generating a topic. Contrary to the Examiner's contention, the generation and storage of topics is an valuable "real world useful result." For instance, these topics can be used to facilitate categorization of documents, searching for documents, associating advertisements with documents, understanding the nature of documents stored on a system. Within the Information Age, the identification of topics is akin to the mining of precious metals or the extraction of a chemical compound from a plant or other substance. Like chemical compounds and precious metals, topics are extraordinarily valuable and have a multitude of uses. The process of extracting or identifying these tangible results (e.g., topics, gems, compounds) from the medium of their storage (e.g., large volumes of text, large volumes of rock, or large volumes of a plant) is very valuable and provides real world useful results.

Thus, Applicants submit that independent claims 1 and 16, and their dependent claims clearly recite a practical application with a useful, concrete, and tangible result and are statutory under 35 U.S.C. § 101.

The Examiner has also rejected claims 16-19, 22-24, 26 and 39 under 35 U.S.C. § 101, alleging that these claims are "software per se." Applicants respectfully traverse.

In 1995, the Commissioner of Patents and Trademarks conceded to the U.S. Court of Appeals for the Federal Circuit "that computer programs embodied in a tangible medium, such as floppy diskettes, are patentable subject matter under 35 U.S.C. § 101." See *In re Beauregard*, 53 F.3d 1583 (Fed. Cir. 1995). The rejected claims fall within what the Commissioner of Patents and Trademarks had conceded was patentable subject matter. Accordingly, Applicants respectfully requests that the Examiner reconsider and withdraw this rejection of claims 16-19, 22-24, 26 and 39 and find them allowable.

Rejections under 35 U.S.C. § 112

Claims 29 and 39 have been rejected under 35 U.S.C. § 112 as failing to comply with the written description requirement. The Examiner has indicated that '[b]ecause the "negative limitation" in lines 10-12 of claim 29 and in line 11-13 of claim 39, "the most identified stored data items not associated with a previously identified display topic' is not supported in the instant specification. Any claim containing a negative limitation must have basis in the original disclosure." Applicants respectfully traverse.

Paragraphs 0006, 0039, and 0040 of the original specification disclose this negative limitation. Furthermore, this negative limitation was disclosed in original claims 29 and 39. Thus, claims 29 and 39 do comply with the written description requirement of 35 U.S.C. § 112. Accordingly, Applicants respectfully request that the

Examiner reconsider and withdraw this rejection of claims 29 and 39 and find them allowable.

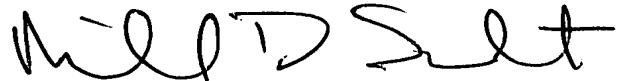
Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

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